

REMARKS

Claims 16-30 remain pending in this application. None of the claims have been amended in this response.

Claims 16-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Haskell*. (US Patent No. 6,233,356) in view of *Bannon et al.* (US Patent No. 6,272,253). The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

The cited art, alone or in combination, does not disclose not teach all the elements in the present invention. Specifically, neither *Haskell* nor *Bannon* disclose "coding the picture objects with different quality; assigning a quality specification indicating the quality with which a picture object is coded to at least one macroblock contained in the corresponding picture object; and determining the quality by a spatial resolution" as recited in claim 16 and similarly recited in claim 26.

Haskell discloses an encoding system wherein one or more video object planes (VOPs) can be encoded in a lower and higher quality. Depending on the computing power, all of the image objects (i.e., the entire digitized picture) are reconstructed under a lower or higher quality (col. 2, lines 35-47). However, *Haskell* does not disclose coding the picture objects with different quality. *Bannon* also does not code the picture objects with different quality, but instead discloses a bit map for establishing a contour representation of a macroblock boundary (col. 8, lines 30-53). It follows that if neither of the references teach coding picture objects, within the same picture, with different qualities, they also cannot assign quality specifications and determine that quality by special resolution as recited in claim 16 and similarly recited in claim 26.

Furthermore, there is no teaching or suggestion to combine the *Haskell* reference with the *Bannon* reference. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills* 916 F.2d at 682, 16 USPQ2d at 1432 (MPEP 2143.01). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143). In the Office Action, the Examiner interchangeably argued features of the *Haskell* and *Bannon* references as though they were a single reference. The rejection ends with

the conclusion that "it was well known in the art that if objects were to be segmented out of a picture, the edges must be found and macroblocks making up those edges must be identified and labeled as contour blocks." (Office Action bottom of page 2). First, this generalization incorrectly describes the features of the presently claimed invention (see above), and secondly, it erroneously imports features that are not taught in the *Haskell* reference. *Haskell* teaches the use of video object planes (VOPs) to capture video objects and video object layers to create composite images (see col. 4, lines 20-37, 64-67). In contrast, *Bannon* is directed towards using compression schemes to create transmissions of video that are bandwidth efficient (col. 2, lines 43-59; col. 3, lines 55-62). In fact, *Bannon* makes no mention of VOP's whatsoever. Why would one of ordinary skill in the art, utilizing the VOP configuration of *Haskell*, turn to the compression scheme taught in *Bannon*? A patent claim is not a road map for the Examiner to search out each patent limitation and combine them in an obviousness rejection. Motivation must be found to combine references and no motivation is found to combine *Bannon* with a modified *Haskell* in order to find the present invention obvious.

For at least these reasons, the Applicants submit that the rejection under 35 U.S.C. §103 is improper and should be withdrawn. An early Notice of Allowance is earnestly requested.

A petition for a one-month extension of time has been submitted with this response, along with a check in the amount of \$110. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (112740-446) on the account statement.

Respectfully submitted,

BELL BOYD & LLOYD LLC

BY 

Peter Zura

Reg. No. 48,196

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4208

Dated: April 19, 2004